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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,573	06/26/2003	Todd Karakashian	BEAS-01282US1	4687
23910 7590 05/01/2007 FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			EXAMINER SHAW, PELING ANDY	
			ART UNIT 2144	PAPER NUMBER
			MAIL DATE 05/01/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/606,573	Applicant(s) KARAKASHIAN ET AL.	
	Examiner Peling A. Shaw	Art Unit 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/28/03, 10/14/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Priority

1. This application is a CIP of 10/366,236 filed on 02/13/2003 which claims benefit of 60/359,098 filed on 02/22/2002 and claims benefit of 60/392,217 filed on 06/27/2002. The filing date is 06/26/2003.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3-11 and 13-20 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-6 and 8-10 of copending Application No. 10/366,236. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application.

Claim Rejections - 35 USC § 112, second paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph as following:

- a. Claim 1 recites the limitation of "the message context" in lines 5 and 7. There is insufficient antecedent basis for these limitations in the claim. Claim 1 and its dependent claims 2-10 are rejected.
- b. For the purpose of applying art, claim 1 is read on lines 5 and 7 with "the context information" instead of "the message context".

Appropriate corrections are required.

Claim Rejections - 35 USC § 101 Utility

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- a. Claim 1 recites the limitation of “A system for providing ...” with further limitations describe a container driver, an interceptor and an invocation handler. It renders claim 1 as software per se system. As such, the claim lacks the necessary physical articles or objects necessary for it to be a machine or a manufacture within the meaning of 35 USC 101, and it's clearly not a series of steps or acts so as to be a process or combination of two or more substances so as to be a composition of matter, it fails to fall within a statutory category. Since the claim is not limited to embodiments eligible for patent protection, it is being rejected as non-statutory subject matter rather than a patent-eligible machine, manufacture, process or composition of matter. Claim 1 and its dependent claims 2-10 are thus rejected.
- b. For the purpose of applying art, claims 1-10 are read as “A storage medium contains software system applications for providing access to web service, comprising: ...” and “The storage medium of claim 1, ...” respectively.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Amirisetty et al. (US 7152090 B2), hereinafter referred as Amirisetty.

- a. Regarding claim 1, Amirisetty disclosed a system for providing access to web services (column 1, lines 52-56: J2EE CA), comprising: a container driver that accepts invoke requests from a client for web services (column 1, lines 60-62: CCI; column 5, lines 54-61: invoke through J2EE CA connector), an interceptor that receives context information for the invoke request from said container driver, and modifies the message context to be used with web services (column 6, lines 8-18: modify metadata content); and an invocation handler that receives the modified context information from said container driver, passes parameters from the message context to the target of the request, processes values returned from the target, and passes the values to the container driver, such that the container driver can formulate a response to the invoke request (Fig. 4; column 6, line 63-column 7, line 17: high-level function invoke low-level calls in sequence through connector; column 8, lines

10-21: sequence of low-level function calls perform high-level function and return results).

- b. Regarding claim 2, Amirisetty disclosed the system of claim 1 wherein the client utilizes JAX-RPC to invoke the web services (Fig. 3; column 13, lines 13-25: server wrapper receives JAX-RPC).
- c. Regarding claim 3, Amirisetty disclosed the system of claim 1 wherein said container driver is adapted to perform any data binding and unbinding required to process the invoke request (column 12, lines 12-20 and 44-55: JAXB).
- d. Regarding claim 4, Amirisetty disclosed the system of claim 1, further comprising a protocol adapter that intercepts web service invoke requests and passes the web service invoke requests to said container driver (column 9, lines 14-20: CCI adaptor provide a unified representation; lines 44-46: see Business XML; column 10, lines 30-35: convert Business XML to protocol XML).
- e. Regarding claim 5, Amirisetty disclosed the system of claim 4, wherein said protocol adapter converts the format of an invoke request and create a message context containing the invoke request (column 9, lines 14-20: CCI adaptor provide a unified representation; lines 44-46: see Business XML; column 10, lines 30-35: convert Business XML to protocol XML).
- f. Regarding claim 6, Amirisetty disclosed the system of claim 1, further comprising a plugin component to be used by said container driver to perform any data binding and unbinding (column 10, lines 30-42: pluggable JAXB).

- g. Regarding claim 7, Amirisetty disclosed the system of claim 1, further comprising an invocation context for storing arbitrary context data useful in processing the web request, said invocation context available to at least one of said interceptor and said invocation handler (column 11, lines 27-35: metadata stored in metadata repository).
- h. Regarding claim 8, Amirisetty disclosed the system of claim 1, wherein said invocation handler manages security policies, transaction management, and target object life cycle for the request (column 1, lines 52-60: managing resource pooling, transactions and security).
- i. Regarding claim 9, Amirisetty disclosed the system of claim 1, further comprising a web service container for hosting said container driver, said interceptor, and said invocation handler (column 1, lines 52-60: J2EE CA in Web/Application server).
- j. Regarding claim 10, Amirisetty disclosed the system of claim 1, further comprising a target object to which said invocation handler can delegate processing the invoke request (column 13, lines 13-25: request payload as input to target function).
- k. Claim 11 and 20 are of the same scope as claims 1, 3 and 9. These are rejected for the same reasons as for claims 1, 3 and 9.
- l. Claims 12-15 and 17-19 are of the same scope as claims 1-5 and 7-10. These are rejected for the same reasons as for claims 1-5 and 7-10.
- m. Regarding claim 16, Amirisetty disclosed the method of claim 11, wherein said step of binding the message context comprises using a codec selected from the group consisting of Java Binding codecs, SOAP codecs, XML codecs, and custom codecs

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(column 12, lines 44-67: content-specific interface, e.g. XML, SAX, JAXB and SOAP, DOM, JDOM).

Amirisetty disclosed all limitations of claims 1-20. Claims 1-20 are rejected under 35 U.S.C. 102(e).

Remarks

6. The following pertaining arts are discovered and not used in this office action. Office reserves the right to use these arts in later actions.

- a. Banerjee et al. (US 20030131049 A1) Internationalization of the web services infrastructure
- b. Baller et al. (US 20030118353 A1) Method and apparatus for managing intelligent assets in a distributed environment
- c. Brown et al. (US 20030110242 A1) Method and apparatus for dynamic reconfiguration of web services infrastructure
- d. Brittenham et al. (US 20020178254 A1) Dynamic deployment of services in a computing network
- e. Humpleman et al. (US 6466971 B1) Method and system for device to device command and control in a network: web service
- f. Faccin et al. (US 20020120729 A1) Internet protocol based service architecture
- g. Merrick et al. (US 7028312 B1) XML remote procedure call (XML-RPC)

Conclusion

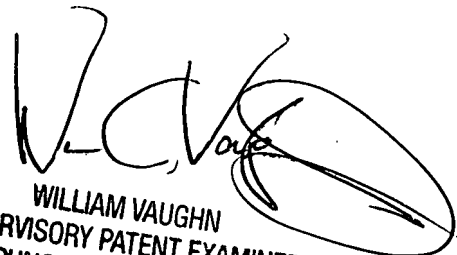
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peling A. Shaw whose telephone number is (571) 272-7968. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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WILLIAM VAUGHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100